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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/522,819

01/31/2005

Yutaka Shibui

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7590

03/17/2009

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EXAMINER

SCHWARTZ, DARREN B

ART UNIT

PAPER NUMBER

2435

MAIL DATE

DELIVERY MODE

03/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/522,819</p>	<p>Applicant(s) SHIBUI ET AL.</p>	
	<p>Examiner DARREN SCHWARTZ</p>	<p>Art Unit 2435</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 March 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-9.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See continuation sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Kimyen Vu/
Supervisory Patent Examiner, Art Unit 2435

/DARREN SCHWARTZ/
Examiner, Art Unit 2435

Applicants' arguments in the Remarks filed on 03/09/2009 have been fully considered but they are not persuasive.

Applicants' arguments:

- a) Berstis does not teach or suggest "a processing section for processing to read out, when a device inherent password inherent to the machine tool program unauthorized-use preventing device and set by a manufacturer of the machine tool program unauthorized use preventing device is input;" and "when a machine tool inherent password different from said device inherent password, inherent to the machine tool, into which the machine tool program unauthorized-use preventing device is installed, and set by a manufacturer of the machine tool."
- b) "Berstis is directed to a multi-user video hard disk recorder, but Paniwani is directed to a communication system including a mobile station. Therefore, there is no motivation for one of ordinary skill in the art to modify the references to achieve the claimed combinations. Thus, the Office Action does not clearly articulate a reason why."
- c) "[N]either Berstis, nor Arnold, nor any combination thereof, teaches 'a processing section for processing to read out, when a device inherent password inherent to the machine tool program unauthorized-use preventing device and set by a manufacturer of the machine tool program unauthorized use preventing device is input, ... when a machine tool inherent password different from said device inherent password, inherent to the machine tool, into which the machine tool program unauthorized-use preventing device is installed, and set by a manufacturer of the machine tool.'"
- d) "[T]here is no motivation for one of ordinary skill in the art to modify the references to achieve the claimed combinations. Thus, the Office Action does not clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art. Accordingly, no prima facie case of obviousness has been established. The 35 U.S.C. § 103(a) rejection of claims 4 and 5 is improper and should be withdrawn."

The Examiner disagrees for the following reasons:

Per a) Berstis does teach a processing section (Fig. 1A; data processing unit 102) for processing to read out (col. 3, lines 31-32; graphical information is displayed on screen 105), when a device inherent password [master user password] inherent to the machine tool program unauthorized-use preventing device and set by a manufacturer of the machine tool program unauthorized use preventing device (col. 7, lines 43-49; the master user enters the new user's name and selects a password for the new user (step 316); rather than setting a password, a variety of security controls may be used for each user in the system; these security controls may be include a smart card for each user, or some other type of security mechanism) is input (Fig. 3, items 302 and 304; col. 7, lines 14-16);" and "when a machine tool inherent password [user password] different from said device inherent password, inherent to the machine tool, into which the machine tool program unauthorized-use preventing device is installed, and set by a manufacturer of the machine tool (col. 7, lines 43-49; the master user enters the new user's name and selects a password for the new user (step 316); rather than setting a password, a variety of security controls may be used for each user in the system; these security controls may be include a smart card for each user, or some other type of security mechanism).

Per b) It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the data processing unit meets the "machine tools" & "machine tool programs" and its recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Regarding the motivation to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Berstis with the teachings of Panjwani for the purpose of preventing modification and protecting data between two parties.

Per c) Please refer to arguments addressed in section a) above.

Per d) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would be obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Arnold with the teachings of Berstis to validate external data usable by said security device for the purpose of using authenticate data proved on an external medium.

